

My REMARKS - Page 1 of 4

REMARKS

I would like to thank Examiner HOA CAO NGUYEN, for his advice and suggestions during our telephone interview on Friday, April 4, 2008. He clarified a lot of issues and I feel strongly that he got me now on the right track. Thank you very much.

I had sent an email dated April 1, 2008 to Examiner, together with the two following documents, about my proposed “Amended Claims” and “Remarks”:

1. OC1-1_PA_17_08331-2_My_Proposed_Amended_Claims.doc, and
2. OC1-1_PA_17_08331-3_My_Proposed_Remarks.doc.

Examiner had reviewed them and has indicated to me on the phone, that the **two** remaining key issues are the expression “**at least two or more pads**” in the amended claims and the issue of “**motivation**”. I will address each one separately here below.

I will **not** repeat the full content of the two above documents. I may refer to those documents as **Reference 1 and 2**, if I need to refer to any of them. But I will just highlight the issues that Examiner, during the telephone interview, has recommended that I address here.

1. “at least two or more pads”

I have modified my claims in **Group 1, namely Claims 59-62 and Claims 68-71** and used the term “**array**” to describe the pad formation, as can be seen in the attached “**IN THE CLAIMS**”. I have also corrected the claims as recommended by Examiner. Thank you for all the advice and help.

My REMARKS - Page 2 of 4

2. “motivation” in the Prior Art US Patent #5,484,963 to Washino.

My **second group** claims comprises my claims 63-67 and claims 72-76, as per **paragraph 8** of the Office Action. The key objection against these claims is Prior Art US Patent 5,484,963 to Washino. I will refer to this prior art as **Washino**.

The big obstacle in the way of this Group 2 of claims is the question or issue of “Obviousness” under 35 U.S.C. 103 (a).

Basically, Examiner states in paragraph 8 of the Office Action, that a person with ordinary skill in the art, I will refer to such a person as “**the skilled person**”, could have easily rotated Washino’s pads by 90 degrees, and would have thus arrived to my invention, because it is easy for a designer to do so, i.e. to rotate any figure by 90 degrees. So, according to Examiner, in so many different words, my invention would have been “obvious” to the skilled person.

I would like to respectfully disagree and to point out that I believe that such a decision is in error.

The basic reason is the issue of “Motivation”. The “motivation” does not exist in the Washino Prior Art, which could have motivated or encouraged the skilled person to change the orientation of Washino’s pad, to arrive at my invention.

The Reference does not suggest to rotate the pads in any direction other than the direction specified in Washino Prior Art, because if the pads would be rotated, then they would not meet the shrinkage problem in the direction specified by Washino. Changing the direction of Washino Prior Art pads would have been against the specification in that Prior Art.

My REMARKS - Page 3 of 4

Let me explain further.

I fully agree with Examiner that a skilled person could have rotated the pads by 90 degrees.

Actually, the skilled person could have rotated the pad not only by 90 degrees, but he could have rotated the pads by any number of different angles.

However, we may, or rather we should, still ask ourselves the following questions:

1. “Why?” and
2. Why 90 degrees? and
3. Why not 60 degrees, or 45 degrees, or any other angle? and
4. What would be the “motivation” of the skilled person to do so? and
5. Was there any “teachings, suggestions, or motivations” in Washino to lead a skilled person to do this rotating of Washino’s pads?

Another question is the following one, but let us just concentrate on the “motivation” question, as Examiner has suggested.

6. What would be the effect of rotating the pads by 90 degrees on the “intended use” of Washino’s pads?

I would like to respectfully refer Examiner to “**MPEP 2143.01 Suggestion or Motivation To Modify the References [R-6] - 2100 Patentability**” and particularly to **Paragraph I. *PRIOR ART **>SUGGESTION OF< THE DESIRABILITY OF THE CLAIMED INVENTION**. I would like Examiner to reconsider and retest my claims, in light of this section of the MPEP and then review the following points and decide whether any of them could save my case here, i.e. could make my claims acceptable and allowable. I would highly appreciate that.

I would like to paraphrase here below the following portions from the above MPEP.

My REMARKS - Page 4 of 4

1. Paragraph I of Appendix A: I. *PRIOR ART **>SUGGESTION OF< THE DESIRABILITY OF THE CLAIMED INVENTION

Obviousness can * be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)* (discussing rationale underlying the motivation-suggestion-teaching *>test< as a guard against using hindsight in an obviousness analysis).

Accordingly, we can ask the following questions:

Q1. Does the “Washino” prior art “teach, or suggest, or motivate” the desirability of the claimed invention? I feel that the answer is: No.

Q2. Is there any motivation in Washino’s prior art that may lead “the skilled person” to do the change, i.e. rotating the pads by 90 degrees. I feel that the answer is again: No.

Q3. Does Washino “teach away” and “de-motivate” any skilled person from rotating his pads by 90 degrees?” I feel that the answer is: Yes.

In conclusion, I feel that we can agree that Washino’s prior art does not provide any teaching, suggestions, or motivation to rotate his pads or to change the orientation of the pads. In fact, Washino goes to a large extent to explain why he insists on having his pads oriented the way he has, and he repeatedly states that in his claims as well. I suspect that if the skilled person rotates Washino’s pads by 90 degrees, Washino would have had a fit of anger against that skilled person.

In light of the above, I believe that Examiner could reconsider my claims in this Group 2 to see if they could be considered as “non-obvious” and hence “allowable”.

Assuming that the above claims of Group 2 are allowable, and assuming that my amended claims of Group 1 are also acceptable as well, then I respectfully request Examiner to grant me the favor of allowing my claims and of issuing a patent.

Thank you very much and best regards.

Gabe Cherian

/Gabe Cherian/